

### **Remarks and Arguments**

Claims 1-22 are pending in this application. Claims 1, 3, 4, 5 and 8 have been amended to more particularly point out the invention. Support for the amendment is found in the specification in Figures 1, 2, 3, and 8. Claim 13 has also been amended to more particularly point out the invention. Support for this amendment is found in the specification on page 7, lines 11-15, and Figures 1, 5 and 8. New claim 23 has been added to more particularly point out the invention. Support for the new claim can be found in the claims as originally filed.

Claims 1- 9 and 11-22 stand rejected under 35 U.S.C. § 102, in view of U.S. Patent No. 6,159,368 (hereinafter, "Moring") and under 35 U.S.C. § 103 in view of Moring and U.S. Patent No. 5,498,545 (hereinafter, "Vestal"). The Office has objected to claim 10, but has deemed the subject matter allowable if rewritten in independent form including all of the limitations of the base claim. Applicants respectfully traverse the rejections.

#### **35 U.S.C. § 102**

Claims 1-3, 5-8 and 11-21 stand rejected as allegedly anticipated by Moring.

The standard for anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir.1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Amended Claim 1 recites in part: a collection plate, which contacts the first sample processing device and is stacked below said first sample processing device to form an integral stacked unit.

Applicants do not believe that Moring discloses a collection plate, which contacts the first sample processing device and is stacked below said first sample processing

device to form an integral stacked unit. In the Office Action dated December 16, 2005 the Office pointed to a first sample processing device (10), a second processing device (24) stacked below the first processing device. The Office is invited to consider Figures 2 and 3 in Moring with particular focus on (10) and (24), as well as (14), described by Moring as a drip director plate (column 12, lines 57-58). Applicants respectfully submit that (10) does not contact (24) and thus Moring is not anticipatory. Applicants request withdrawal of the rejection of claim 1 and its dependencies claims 2-9 and 11-12.

Turning to claim 13, Applicants have amended claim 13 to recite in part: a base in sealing engagement with said collar, the base comprising an outer peripheral flange and a side wall which together form a peripheral groove and wherein a portion of the flange contacts a slot formed in the collar. Applicants do not believe Moring discloses this element. In this regard the Office is invited to consider Figure 3 in Moring once again, with particular focus on (38), which the Office believes is a collar and (51), which the Office believes is a base. Applicants note that there is no peripheral flange, nor is there a slot in the collar which is contacted by the flange. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claim 13 and its dependencies claims 14-15.

Turning to claim 16, Applicants note that the Office maintained the rejection in the Advisory Action dated October 17, 2006, but provided no reason for doing so. Moreover, Applicants note that no reason was provided for maintaining this rejection in the Final Rejection dated June 15, 2006 either. Applicants urge the Office to consider that claim 16 is a method claim. The claim recites various steps including: "A method of applying vacuum to a manifold assembly, comprising: . . . applying a vacuum to said manifold with said vacuum source, whereby said collar is forced into sealing engagement with said base without causing movement of said sample processing unit," (emphasis added). Applicants believe that no reference of record teaches this step in the recited method. Moreover, with respect to Moring the Office is again urged to consider Figure 2, with particular focus on gaskets (42) and 44. Applicants believe that relative movement of (10), (34) and (28) with respect to one another will result when an external force, such as a vacuum, is applied. Thus, Applicants believe the steps of the method claim are not anticipated by Moring or any other reference of record.

Accordingly, Applicants again request the Office to withdraw the rejection, or alternatively, point to a specific reference which recites all of the claim elements.

### **35 USC §103**

Claims 4 and 22 stand rejected as allegedly obvious in light of Moring in view of Vestal. The Office believes that Moring teaches all the elements of the claims, but admits that none of these references teach a MALDI device as the second device. According to the Office, Vestal teaches a mass spectrometer system for analyzing multiple samples. The Office believes that Vestal discloses a system including a sample plate for holding samples on pins in wells of a plate. The Office concludes it would have been obvious to combine Vestal with the device of Moring. The Office further states that one would use the plate of Vestal as the collection plate in order to load the collection plate for MALDI analysis of the samples. Applicants respectfully traverse the rejection.

### **The Prima Facie Case Requirement**

The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP §2142. MPEP §2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations." The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141. The Office has not met its burden in establishing a prima facie case of obviousness.

For the reasons set forth above, Moring does not teach or suggest every claim limitation of claim 4 or 22. Vestal does nothing to cure this defect. Accordingly the claims are not prima facie obvious.

Moreover, Applicants note that the Office has not pointed to anything in the cited references that would motivate the skilled artisan to make the suggested combination. The references themselves must suggest the desirability of making the suggested combination. Applicants believe there is nothing of record that suggests such motivation. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **Objection**

Applicants submit that the objection to claim 10 is moot in light of the remarks presented above.

### **CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account.

Respectfully submitted



E. Stewart Mittler

Attorney for Applicants  
Reg. No.50,316

October 31, 2006  
Millipore Corporation  
290 Concord Road  
Billerica, Massachusetts 01821

Tel.: (978) 715-1086  
Fax: (978) 715-1382